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10/014,103

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Alex Mashinsky

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7590 10/10/2007  
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| EXAMINER |
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BORLINGHAUS, JASON M

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| ART UNIT | PAPER NUMBER |
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3693

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10/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                  |                                  |  |
|------------------------------|----------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/014,103    | Applicant(s)<br>MASHINSKY ET AL. |  |
|                              | Examiner<br>Jason M. Borlinghaus | Art Unit<br>3693                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/23/07 has been entered.

### ***Claim Objections***

**Claims 35 – 37** are objected to because of the following informalities: lack of antecedent basis. Claims 35 – 37 reference “the deal requirement” rather than the previously claimed “deal execution requirement.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 –34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US Patent 6,324,519) in view of Wagner (US Patent 4,903,201) and Official Notice.

**Regarding Claims 1 - 2, 8, 15 – 20 and 35**, Eldering discloses a system for trading media space, comprising:

- a server node (server) operatively connectable to user interfaces for receiving a request for media space (advertising space/opportunities) from a buyer (advertisers) and offers of media space (advertising space/opportunities) from sellers (content providers), said server node (consumer profile server) comprising a set of rules (correlation operation) for matching (correlating) the request and the offer in accordance with a said set of rules. (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said server node (server) configured to facilitate delivery of media content (advertisement) between the matched (correlated) buyer (advertiser) and seller (content provider) in response to the executed trade (accepted bid). (see col. 1, lines 45 - 55);

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- wherein said server node (server) is further configured for sending (transmitting) notice of the match (correlation results) to the matched buyer and seller. (see col. 10, lines 20 – 36).
- wherein said server node (server) is connectable to the buyers and the sellers via a wide area communication network (Internet). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein the media space is an ad space on one of television (broadcast video programming). (see col. 1, lines 38 – 44);
- wherein the media space includes attributes comprising at least on target market (demographics). (see col. 2, lines 11 – 14);
- wherein the buyers and sellers are market participants, wherein the market participants comprise at least one of an advertiser (advertiser). (see fig. 1A);
- wherein further comprising an interface (Internet) through which the buyers and sellers interact with said server node, said interface comprising at least one of a computer. (see col. 8, line 40 – col. 9, line 5); and
- wherein each of said requests and offers comprise parameters (vectors) and said set of rules matches the request and offers based on at least one of the parameters (vectors) that is different from the cost of the media space (such as demographic matching or product preference matching). (see col. 1, line 45 – line 2, line 14).

Eldering does not explicitly disclose that said requests and offers being stored in a database of the server; nor matching the requests and offers stored in the database, although Eldering does recognize that storage of information within the system would be required, as Eldering discloses the usage of a database (see col. 8, lines 60 – 65) and data storage devices, such as hard drives (see fig 4). (emphasis added),

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering by incorporating a database, as disclosed by Eldering, for storage of submitted requests and offers for advertising, allowing for storage of data to be processed by the system to be stored within the system.

Furthermore, usage of databases and data storage devices within a computerized system is old and well known in the art of computer system design, and usage of such components would have been standard and conventional at the time the invention was made.

Eldering does not explicitly state that the matching is automatic. (emphasis added). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Eldering does not teach the inclusion of a deal execution requirement for executing at least one trade between a matched buyer and seller in accordance with the deal execution requirement, although Eldering does disclose a deal execution stage (selection of bid) for executing at least one trade between a matched (correlated) buyer (advertiser) and seller (provider) in accordance with the deal execution stage. (emphasis added - see abstract).

Eldering also does not teach notification of such executed trade nor activities related to finalizing the execution, such as clearing, settlement and billing for the executed trade. However, such activities are notoriously old and well known in the art of matching or trading systems.

To that end, Wagner discloses a system for trading wherein there is the inclusion of a deal execution requirement should a match between a buyers request and a sellers offer and the exercising of such an execution requirement (executes matching bids and offers); notification of such executed trade (notifies traders of filled or unfilled orders); and clears (executes and clears trades simultaneously) billing and transmission of information for further settlement (provides necessary trade data for settlement). (see col. 20, line 54 – col. 21, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering by incorporating such features, as disclosed by Wagner, as such features and/or activities are conventional and standard in the operation of matching or trading systems, allowing a matched request and offer to proceed to transaction completion.

Eldering does not teach the presentation an input screen to the buyer and seller for the request and the offer, although Eldering does teach the input of information by the buyer and seller into a computer system and generally computer systems operate with a screen or display. (emphasis added)

Regardless, Wagner discloses an input screen for the buyer and seller to input their request and offer. (see fig. 19).

It would have been obvious to one of ordinary skill in the art to have modified Eldering and Wagner by incorporating an input screen, as disclosed by Wagner, allowing a visual interface to facilitate the inputting of data into the system, thereby increasing ease of use for the system.

**Regarding Claims 3 – 7**, Eldering discloses a system for trading media space further comprising:

- a delivery system (network) having a connection between said server node (customer profile server), a buyer's content database (ad server) and a seller's content database (content server), wherein the media content (advertisement) is delivered from the buyer's content database (ad server) to the seller's content database (content server) via said connection. (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said delivery system further comprises a contents database (ad server) connected to a network and configured to store media content (variety of advertisements), the delivery system being configured to receive the media content from the buyers (advertiser) when the requests



(request for advertising space/opportunities) are submitted to the server node (server) and storing the media content (variety of advertisements) in the content database (ad server), and the delivery system being configured to deliver the media content (advertisement) from the content database (ad server) to the one of the sellers (content providers) of the matched (correlated) pair via the connection (network). (see abstract; fig. 1 and 7; col. 4, lines 8 – 11; col. 9, line 32 – col. 12, line 26);

- wherein said connection to said buyer's content database (ad server) and said seller's content database (content server) via a file transfer means (transport protocols). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said connection to said buyer's content database (ad server) and said seller content database (content server) via a file transfer means (transport protocols) consisting of one of an IP network (Internet) and e-mail system (e-mail messages). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26); and
- wherein said delivery system (network) further comprises a contents database (web site) connected to means for receiving and storing the offered media content (listing of advertising opportunities) from the sellers (content provider) when the offers (advertising space/opportunities) are submitted to the server node (web site) and storing the offered media content (listing of advertising opportunities) in the contents database (web

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site), and means for delivering (Internet) the content media (advertisement) from the buyer (advertiser) to the seller (content provider) of the matched (correlated) pair.

Eldering does not teach the use of a third content database nor the use of a switching node.

As to the third content database, neither the combination of two databases into a third database (the third database being an amalgamation of the prior existing two) nor the creation of an additional third database (the third database operating in addition to the prior existing two database) make the claim limitation patentably distinct. In regards to the combination, The Courts have stated that forming in one piece an article that had formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965). In regards to database duplication, the Courts have also stated that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

Examiner takes **Official Notice** that utilization of a switching node is old and well known in the art of information technology and telecommunications. It would have been obvious to one of ordinary skill in the art to have modified Eldering and Wagner by incorporating such components, devices and/or technologies that were conventional and/or standard in the art of information technology and telecommunications at the time the invention was made.

Furthermore, as a switching node, by definition, would control, transmit and route data packets through a network, usage of a switching node for controlling the flow of data between its various servers and system elements would allow for more efficient and effective routing of information through the system.

**Regarding Claims 9 – 14, 21 – 34 and 36 – 37**, recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized. Applicant is reminded that any argument contrary to such an interpretation is an indication of patentably distinct subject matter that may warrant a restriction requirement.

### ***Response to Arguments***

Applicant's arguments filed 7/23/07 have been fully considered but they are not persuasive.

Applicant argues that one skilled in the art would not have combined the disclosures of Eldering, an advertisement auction system, with the disclosures of Wagner, an automated trading exchange, as such systems are fundamentally different.

However, the Examiner asserts that the prior art references are valid under the analogous arts test. The Courts have stated that to be utilized "as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

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inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). As such "it is necessary to consider "the reality of the circumstances" -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). Examiner asserts that based upon common sense, the field of the references and/or the problem the inventor was concerned about, that the cited prior art references would have been utilized by a skilled artisan in the art, as all prior art references relate to matching requests and offers, and executing such matched requests and offers.

Applicant argues that in Wagner, an automated trading exchange, requests and offers that are matched concern commodities and that "each individual unit of a commodity is the same as [any] other individual units of the commodity." (see Argument's, p. 11). Applicant argues that such commodities are fundamentally different than advertising space as "many other factors other than cost" come into play when purchasing advertising space. (see Argument's, p. 11).

Examiner agrees that advertising space is not a commodity and that different parameters need to be taken into account due to the individual qualities of each advertising opportunity. To that end, Eldering states that the matching (correlating) between offers and requests deal with a multitude of factors such as demographic matching and product preference matching. (see col. 1, line 57 – col. 2, line 13).

All the Examiner is asserting is that after Eldering, an advertising auction system, matches a request and offer for advertising space, utilizing its matching parameters

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pertinent to the advertising industry, that the matched request and offer proceeds down the conventional and standard path for matched requests and offers, as disclosed by Wagner. Examiner is not importing any features of Wagner specific to commodities or that somehow negate the teachings of Eldering but rather are standard and conventional to matching systems, in general, such as deal execution, notification, billing and settlement.

Applicant argues that neither prior art reference, neither Eldering nor Wagner, disclose the use of a database, a newly added claim limitation. Such claim limitation is addressed in the above rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

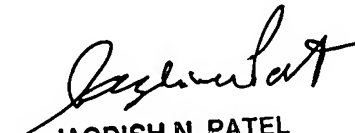
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason Borlinghaus (JMB)

September 29, 2007



JAGDISH N. PATEL  
PRIMARY EXAMINER